REMARKS

A new restriction requirement and election of species was set forth in the Office action dated December 18, 2002. A new restriction between the apparatus claims 1-21 and 29-52, and the method claims 22-28 was required. And a new election between five different species (drawn to Figures 5, 7, 8a and 8b, 9, and 10, respectively) was also required.

In a telephone conference on December 12, 2002, the apparatus claims directed to the species directed to Figure 5 were elected with traverse for examination, and is hereby affirmed in the present response. The Office action identified claims 1-7, 9, 13-21, 29, 34-35, 37-38 and 40-51 as being directed to the elected species. Applicant notes, however, that claim 18 does not appear to be directed to the elected species. Applicant respectfully submits that there is significant overlap of common features in the identified species, and it would not impose a serious burden on the Office to examine the identified species together in a single application.

In the Office action dated December 18, 2002, claims 1-2, 5-7, 9, 13, 19-21, 34-35, 37 -38, 43, 45 and 51 were rejected as being anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,419,693 ("Fariabi"). Claims 3-4, 17, 40-42, 44, and 46-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fariabi. The Office action also noted that this application was examined under the "pre-AIPA" 35 U.S.C. § 102(e).

By the present amendment, claims 17 and 22-28 have been canceled; claims 1 and 9 have been amended, and new claims 53-55 have been added. Claims 22-28 were

canceled as being directed to a non-elected invention. Claims 1-21 and 29-55 are pending and claims 1-7, 9, 13-21, 29, 34, 35, 37, 38, 40-51 and 53-55 are under consideration in the present application. Applicant respectfully requests reconsideration of the present application.

SECTION 102 AND 103 REJECTIONS

Claims 1-2, 5-7, 9, 13, 19-21, 34-35, 37 -38, 43, 45 and 51 were rejected as being anticipated by Fariabi under Section 102(e), and claims 3-4, 17, 40-42, 44, and 46-50 were rejected as being unpatentable over Fariabi under 35 U.S.C. § 103(a).

Claim 1 has been amended to recite that "the main body [of the radiopaque stent] is visible but does not obscure the underlying vessel morphology when subjected to imaging," which was recited in dependent claim 17. Support for this claimed subject matter may be found at page 6, line 3 to page 7, line 8. For example, the specification states that "[t]he image is not 'washed out' due to excessive brightness and not too dim" (*see* page 6, lines 6-8), and "does not produce an image which is excessively too bright, thereby obscuring imaging of the underlying vessel morphology" (*see* page 7, lines 6-8).

Applicant respectfully submits that amending claim 1 to incorporate the subject matter from claim 17 obviates the Section 102(e) rejection of independent claim 1 and all claims dependent thereon. With respect to the Section 103 rejection, the Office action asserted that:

> [T]he stent of Co-Ni-Cr alloy such as the L605 alloy as specified in the elected species ... is well known for the radio opaqueness and has been know to be used to make a radio

> opaque stent (please see WO 00/54704, which has a equivalent U.S. application 09/270,403 filed on March 16, 1999 prior to the filing date of this present application).

Applicant notes that the Office action has already stated that this application was examined under the "pre-AIPA" 35 U.S.C. § 102(e). And neither WO 00/54704 nor U.S. application 09/270,403 is prior art under the "pre-AIPA" 35 U.S.C. § 102(e). To the extent that the Section 103 rejection was based on either reference, the Section 103 rejection should be withdrawn.

Moreover, even assuming that either reference was properly prior art, there is no motivation for the modifications noted in the Office action because neither reference discloses using the L605 alloy as a radiopaque material to make a radiopaque stent. Indeed, WO 00/54704 describes the L605 alloy as a "non-radiopaque" alloy. Specifically, WO 00/54704 states at page 5, lines 19-23 that:

> Where a superelastic alloy such as NiTi is used as a cladding layer in combination with a **non-radiopaque** high strength alloy substrate such as stainless steel, MP35N or L605, it is generally preferred to include a second cladding layer or tube of a radiopaque metal such as those described above. In this way, the desired mechanical characteristics of the stent can be achieved with the appropriate combination of substrate and first cladding materials, and radiopacity is added to the stent by the second cladding layer or tube.

The published PCT application WO 00/54704 is directed to a composite stent having a non-radiopaque substrate (such as L605 alloy) to which a cladding layer of radiopaque material is laminated. If the Office action were correct in suggesting that WO 00/54704 teaches that "L605 alloy has been recognized as a suitable radio opaque material to make a radio opaque stent," then the cladding layer of radiopaque material in

WO 00/54704 would be superfluous. WO 00/54704 does not teach using L605 alloy as a radiopaque material to make a radiopaque stent.

With respect to the Section 103 rejection of claim 49, Applicant also respectfully submits that the Office action has provided no prior art teaching of a cobalt chromium alloy capable of at least 30 percent elongation. Applicant respectfully requests that the Section 103 rejection be withdrawn for this reason as well.

Claim 9 has been amended to provide proper antecedent basis for the claimed "solid radiopaque tube."

New claim 55 has been added to recite that the cylindrical main body of the radiopaque stent "has a wall thickness of no more than about .004 inches." With respect the suggestion in the Office action (*see* page 6) that it would have been obvious to make the FARIABI stent "thick enough such that the stent main body is visible as recited in the claim," Applicant respectfully submits that Fariabi does not disclose a stent having "a wall thickness of no more than about .004 inches" as recited in the claim.

NEW CLAIMS

Support for new claims 53, 54 and 55 can be found at page 11, lines 20-22; page 12, lines 1-10; and page 15, lines 13-14; respectively. Applicant notes that claim 54 may be drawn to an unelected species, but Applicant respectfully submits that it would not impose a serious burden on the Office to examine the species together in a single application.

CONCLUSION

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

In light of the above amendments and remarks, Applicant respectfully requests early and favorable reconsideration in this case.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

1. (Amended Once) A radiopaque stent comprising a cylindrical main body comprising a radiopaque cobalt chromium alloy that comprises cobalt, chromium, and one or more radiopaque materials; wherein the main body is visible but does not obscure the underlying vessel morphology when subjected to imaging.

9. (Amended Once) The radiopaque stent of claim [6] 8 wherein the solid radiopaque tube defines holes

New Claims 53-55 have been added.